

### REMARKS

This paper is responsive to the Office Action mailed November 2, 2007. Applicants acknowledge the Examiner's decision to vacate the Office Action mailed July 18, 2007; however, Applicants protest the form of this new Office Action, which vacates the previous restriction, issues a new restriction, yet maintains the Applicants' initial election of an invention group and selection of a species.

#### Overview

The numerous requirements for restriction and the Examiner's repeated misidentification of both invention groups (i.e., I, II, III, etc.) and formula (i.e., Formula I, II, etc.) has made this case difficult to follow. In an effort to clarify this application and to further prosecution, Applicants have attempted to summarize the case below.

This is the **second** requirement for restriction received from the Office. In an Office Action mailed March 22, 2007, a first restriction of Applicants' invention was required between claims to compositions according to Formula II (Group I, Claims 1-25<sup>1</sup>), compositions according to Formula I (Group III, Claims 28-35), and methods of using the compositions of either Group I or II (Group III, Claims 23-27 and 36-41). An election of species was also required, with the Examiner stating:

"In the instant case, upon election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention will encompass all compounds within the scope of the claim, which fall into the same class and subclass as the elected compound, but may also include additional compounds, which fall in related subclasses. Examination will then proceed on the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification. A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of

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<sup>1</sup> In their response dated April 23, 2007, Applicants pointed out to the Examiner that Group I, as classified by the Examiner, appeared to only encompass Claims 1-22, and that Claims 23-25 appeared to be encompassed by the subject matter of the Examiner's Group II. The Examiner confirmed that Group I actually comprised Claims 1-22 in the Office Action dated July 18, 2007.

compounds along with (if appropriate) the process of using or making said compound under examination. This will be set forth by reference to specific class(es) and subclass(es) examined." (Office Action dated March 22, 2007, page 3.)

In their response dated April 23, 2007, Applicants elected Group I (the compositions of Formula II, Claims 1-22) and selected a species for initial examination, with traverse.

In a second Office Action, mailed July 18, 2007, the Examiner acknowledged Applicants' election of Group I (compositions of Formula II, Claims 1-22) and the selection of a species, and the Examiner then set forth the scope of the invention of the elected subject matter as:

"Compounds of formula I<sup>2</sup> [formula omitted], depicted in claim 1, wherein: **B** is M<sub>n</sub>R<sup>8</sup> defined; **M** is asdefined (sic); **R<sub>8</sub>** is heterocyclic group; **Ar** is a phenyl group; **Q** is nitrogen containing heterocyclic group; **R<sub>5</sub>** is M<sub>n</sub>Q group; **R<sub>6</sub>** is H or OH, and **W** is as defined; **V** is as defined; **R'** and **R''** are as defined; **N** is as defined." (Office Action dated July 18, 2007, page 4.)

The Examiner then continues to state that the elected Claims 1-22 are withdrawn<sup>3</sup>:

"As a result of the election and the corresponding scope of the invention identified supra, claims 1-22 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions." (Office Action dated July 18, 2007, page 4.)

In the Office Action mailed November 2, 2007, Applicants were advised that the Office Action dated July 18, 2007 had been **vacated** and that a new restriction of Applicants' invention was required as between:

**Group I** (Claims 1-22) drawn to compositions of Formula II wherein **Ar** is a phenyl group, **Q** is a nitrogen containing heterocyclic group, and the rest of the variables are as defined;

**Group II** (Claims 1-22) drawn to compositions of Formula II wherein **Ar** is a heteroaryl group, **Q** is a nitrogen containing heterocyclic group, and the rest of the variables are as defined;

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<sup>2</sup> It is assumed the Examiner means compounds of Formula II, Claims 1-22.

<sup>3</sup> It is assumed that Claims 23-41 are actually withdrawn, and that examination of Claims 1-22 will proceed as defined by the Examiner.

**Group III** (Claims 1-22) drawn to compositions of Formula II wherein **Ar** is a phenyl group, **Q** is a tertiary amino substituent group, and the rest of the variables are as defined;

**Group IV** (Claims 23-27 and 41) drawn to methods of use of the compositions of Formula II;

**Group V** (Claims 28-35) drawn to compositions of Formula I wherein **Ar** is a phenyl group and the rest of the variables are as defined;

**Group VI** (Claims 28-35) drawn to compositions of Formula I wherein **Ar** is a heteroaryl group and the rest of the variables are as defined; and

**Group VII** (Claims 36-41) drawn to methods of use of the compositions of Formula I.

The Examiner then continues to set forth a species requirement and rationale for restriction; however, both the species requirement and rationale were directly lifted from the previous Office Actions and therefore refer to incorrect invention groups (*see, e.g.*, pages 4-7 of the Office Action dated November 2, 2008, specifically: page 4 notes that an election of species is required if one of Groups I or III is elected; page 7 states that Groups I and II are related as product and process of use; etc.).

The Examiner *then acknowledges* Applicants *prior* election of previous Group I and election of species, even through that restriction/election requirement has been **vacated**, once again repeats the scope of the invention of the elected subject matter<sup>4</sup> and continues with an Office Action on the merits (*see*, rejections presented under 35 U.S.C. §112, second paragraph, now vacated).

Applicants' representatives are unsure as to the response required by the present Office Action. The following represents a **bona fide** attempt to be fully responsive to the issues that have been newly raised or reopened by the current action, which vacates what has come before.

#### Response to the new restriction requirement

In order to be completely responsive to the new restriction requirement presented in the Office Action mailed November 2, 2007, Applicants hereby elect, with traverse, Group I (Claims 1-22) drawn to

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<sup>4</sup> "Compounds of formula I [formula omitted], depicted in claim 1, wherein: **B** is  $M_nR^8$  defined; **M** is as defined (sic); **R<sub>8</sub>** is heterocyclic group; **Ar** is a phenyl group; **Q** is nitrogen containing heterocyclic group; **R<sub>5</sub>** is  $M_nQ$  group; **R<sub>6</sub>** is H or OH, and **W** is as defined; **V** is as defined; **R'** and **R''** are as defined; **N** is as defined." (Office Action dated July 18, 2007, page 4.)

compositions of Formula II wherein **Ar** is a phenyl group, **Q** is a nitrogen containing heterocyclic group, and the rest of the variables are as defined.

In restricting claims between products and process of use, the Examiner reasons:

"Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP §806.05(h). In the instant case the process claimed can by (sic) materially different process of using that product." (Office Action dated November 2, 2007, page 7)

Applicants acknowledge the rule for determining whether a product and its process of use are distinct set forth in the quotation from the Examiner above. However, Applicants note that MPEP §806.05(h) further states:

"The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement." MPEP §806.05(h).

Applicants note the Examiner has not provided any example of the claimed product being used in a materially different process of using the product, or, alternatively, any example of the claimed process for using the product as claimed being practiced with another materially different product. The Examiner merely states his belief that each of the restricted claim groups is capable of supporting its own patent.

Moreover, Applicants note the process claims, e.g., Claim 23, specifically calls for the use, and recites the actual product specifications, of the product recited in Claim 1.

Regards the restriction of the composition claims, e.g., Groups I-III, it is submitted that a search of the art relevant to the Group I claims will reveal all the art relevant to the Group II-III claims, and vice versa. Applicants note that the **classification** of the respective restriction groups **are identical**. Accordingly, examination of all claims together will be more efficient and less burdensome for both Applicants and the PTO.

Conclusion and Provisional Election

Applicants submit that in view of the foregoing remarks all the claims herein are seen to relate to a single inventive concept, and the claims are in a form and are of the sort that is properly viewed as relating to a single invention that should not be restricted. Applicants request that the restriction requirement of the Office Action of November 2, 2007 be reconsidered and withdrawn.

Although, for reasons set forth above, Applicants believe that the restriction is improper and uncalled for, and without in any way acquiescing in the reasons for the requirements set forth in the Office Action, but in order to be fully responsive to the Office Action, Applicants provisionally elect for examination the claims of Group I, i.e., Claims 1-22.

Rejoinder

Applicants note that method Claims 23-27 and 41 are subject to rejoinder upon the allowance of product claims. As noted by the Examiner and set forth in the MPEP:

"[I]f applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined....Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance." MPEP §821.04.

Applicants submit that Claims 23-27 and 41 currently incorporate the limitations of the product claims, *see, e.g.*, Claim 1. If needed, Applicants will further amend Claims 323-27 and 41 to incorporate any new limitations proposed during the prosecution of the product claims.

Response to Issues presented under 35 U.S.C. §112, second paragraph

In the Office Action, Claims 1 and 11 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner objects to the recitations "isomer" and "N-oxide", stating that it is unclear which specific isomers or N-oxide forms of Formula II Applicants refer to. Applicants disagree that the terms present any confusion; however, in an effort to advance the application, Applicants have deleted the objected to terms from Claims 1 and 11 as requested.

Respectfully submitted,



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date



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